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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/049,816 | 02/19/2002 | Mikito Nishii | 111970 | 2904 |
| 7590 | 10/21/2004 | | EXAMINER | |
| Oliff & Berridge PO Box 19928 Alexandria, VA 22320 | | | HARDEE, JOHN R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1751 | |
| DATE MAILED: 10/21/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/049,816 | NISHII ET AL. |
| | Examiner John R. Hardee | Art Unit 1751 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8, 10-18 and 20 is/are pending in the application.
 - 4a) Of the above claim(s) 15, 17 and 20 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8, 10-14, 16 and 18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 - Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 - Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>09/10/2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-8, 10, 11, 13, 14, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 62-045,681 A. See abstract, which discloses a mixture of 5 parts by weight of silicone oil, 95 pbw of ethylene glycol, 3 pbw of triethanolamine, 0.1 pbw of benzotriazole. 0.8 pbw of phosphoric acid and colorant. This is diluted with water to an ethylene glycol concentration of 30%. The Office does not have the facilities to determine conductivities, but the ionic concentration appears to be small enough and the glycol concentration large enough to meet applicant's limitations. Alternatively, as the cited composition is similar to that being claimed, one would expect them to have similar properties. A cooling cycle of the disclosed coolant and nitrogen can be fairly inferred, as cooling of an engine is the intended purpose of the composition. Silicone oil and ethylene glycol are nonionic. Claim 18 is drawn to intended use, and the product by process limitations of claims 13 and 14 are held to be met in the absence of evidence to the contrary.
3. Claims 1-6, 8, 10-14 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over SU 899,635

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B (abstract). See the disclosed composition. The Office does not have the facilities to determine conductivities, but the ionic concentration appears to be small enough at the low end of the concentration ranges to meet applicant's limitations. Claim 18 is drawn to intended use, and the product by process limitations of claims 13 and 14 are held to be met in the absence of evidence to the contrary.

4. Claims 1-6, 8, 10-14 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 98/40441. The reference is in Japanese. See the composition disclosed at col. 5, lines 45+ of related US 6,083,311. The Office does not have the facilities to determine conductivities, but the ionic concentration appears to be small enough at the low end of the concentration ranges to meet applicant's limitations. Claim 18 is drawn to intended use, and the product by process limitations of claims 13 and 14 are held to be met in the absence of evidence to the contrary.

Response to Arguments

5. The Office appears to have mislaid applicant's response. The examiner apologizes for the delay.

6. Applicant's arguments filed June 18, 2004 have been fully considered but they are not persuasive. Applicant argues that the cited references do not disclose the conductivities of the disclosed compositions. While this is correct, the person of ordinary skill in the coolant art would expect those compositions to have conductivities which meet the recited conductivity limitation because they contain only small amounts of ionic

materials. Regarding rejections under 102/103, see MPEP 2112 and references to *In re Best* and *In re Fitzgerald*. It is incumbent upon applicant to present objective evidence that the cited compositions do not meet the recited conductivity limitations.

7. This office action contains new grounds of rejection which were not motivated by applicant's amendment. Accordingly, this action is NOT FINAL.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (571) 272-1318. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (571) 272-1316.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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John R. Hardee
Primary Examiner
October 19, 2004